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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,182	07/06/2001	Jean-Louis H. Gueret	5725.0701	9798
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER HUYNH, KHOA D	
			ART UNIT 3751	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/899,182	Applicant(s) GUERET, JEAN-LOUIS H.	
	Examiner Khoa D. Huynh	Art Unit 3751	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05/16/07 & 06/28/07.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-335 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-83, 296-301, 308-313 and 320-325 is/are allowed.
- 6) ☒ Claim(s) 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295 and 332-335 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 85-87,90-124,128-130,133-167,171-198,204-230,234-261,267-293,302-307,314-319 and 326-331.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295 and 332-335 are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery (4403624).

Regarding claim 84, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 88 and 89, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and

wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 125 and 126, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 127, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 131 and 132, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second

notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 168 and 169, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 170, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 199 and 200, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as

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mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 201, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 202 and 203, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 231 and 232, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 233, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 262 and 263, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 264, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush.



Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 265 and 266, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 294 and 295, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Each of claims 332-335 recites limitations that are substantially similar to the limitations of claims 84, 127, 170, 201, 233 and 264 which have been rejected as discussed supra.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 336-339 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery (as discussed supra)

Even though the Montgomery reference does not specifically disclose that the core is formed of spiral winding as claimed, it, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Montgomery reference by employing a core formed of spiral winding. Such modification would be considered mere substitution of one functionally equivalent core for another within the cosmetic art that would work equally well on the Montgomery reference. In other words, using a core formed of spiral winding for the Montgomery brush applicator would be a simple substitution of one known brush's core for another to obtain predictable results, i.e. to allow the bristles to be mounted onto the applicator. *KSR, 550 U.S. (2007)*.

***Reissue Applications***

Claims 84-339 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d

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1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Newly added claims 84-339 contain recapture of surrender subject matter. This is impermissible by filing a reissue application to recapture what was surrendered (MPEP 1412). All claims in the original claims 1-29 were allowed based on the applicant amendments and arguments filed on 9/24/1998 and 10/29/1998 in the parent patented file, SN 08/863,193, now U.S. Pat. 5,918,994. In particular, the applicant had amended the claims and argued the importance of the added limitations regarding "non-concave notch back" and "the two secant faces of the notch are asymmetric and form a trough line". The criticality of such "two asymmetric faces form a reentrant angle beta at trough line" is also discussed (see pages 4-6 of the amendment of 9/24/98 and page 4 of the amendment of 10/29/98 and the examiner's reason of allowance mailed on 11/19/98).

Today, the applicant seeks to omit the same limitations added in the parent patent in the newly added claims 84-339. This is recapture.

Furthermore, newly added dependent claims 30-83 contain 35 USC 251 no error. By merely adding dependent claims 30-83 without changing the scope of independent claims is not a correction of 251 error.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: the Reissue Declaration filed 10/29/01 and 12/21/06 failed to properly identify at least one 35 U.S.C.251 error. It is not sufficient for an oath /declaration to merely state "...A brush comprising at least one notch at least two secant faces that form a reentrant angle beta of between 60° to 80° at any point along the trough line. Certain aspects of the invention could be practiced without having such configuration". Patentee seeks to obtain claims having a scope broader than the scope of the claims in the issued patent. Rather, the oath /declaration must specifically identify an error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. (MPEP 1414 II. (C)). The differences between the newly added claims 30-339 and the original claims 1-29 must be pointed out (MPEP 1414).

A Supplemental Oath/Declaration under 37 CFR 1.175(b)(1) is needed to cover errors corrected by amendment filed 5/16/07 (adding additional claims 336-339) and 6/28/07 (claims correction) (add or delete limitations in claims and add or delete claims after filing the Declaration on 12/21/06). Form paragraph 14.05.02 may be used for this matter. To cure this defect, applicant should use Form PTO/SB/51S attached to this

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letter. See MPEP § 1444 for handling supplemental oaths/declarations. The reissue claims broaden the scope of the patented claims in at least one respect even though they are narrower in other respects. MPEP 1412.03(I). Therefore, the Supplemental Declaration must be signed by all inventors (not the assignee). MPEP 1414.01 (III). See also *In re Hayes*, 53 USPQ 2d 1222.

#### ***Allowable Subject Matter***

5. Claims 1-29 (previously allowed claims), 30-83, 296-301, 308-313 and 320-325 (newly added dependent claims that depend on claims 1-29) are allowed over the prior art of record.

#### ***Response to Amendment***

6. Applicant's amendment, filed on 05/16/07 and 06/28/07, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

#### ***Response to Arguments***

7. Applicant's arguments filed on 05/16/07 with respect to the pending claims have been fully considered. However, such arguments are deemed not persuasive.

Applicant also asserts that the Montgomery reference does not teach the gap between the bristles. See remarks section, pages 60-62. The examiner disagrees.

As shown in Figure 13, the Montgomery reference does teach a brush having an elongate core and bristles extending from the core, two notches formed on the external surface of the brush, wherein each of the two notches comprises a front face and a back face. A gap is formed between the bristles and that gap is space away from the

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core. Since the Montgomery reference does disclose each of the claimed features, Montgomery does suggest applicant's invention as claimed.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khoa D. Huynh/  
Primary Examiner, Art Unit 3751